**IN THE DRAWINGS:**

The attached sheet of drawings includes corrections to FIG. 1. This sheet replaces the original sheet including FIG. 1. Specifically, FIG. 1 has been revised to delete the four occurrences of "①" appearing on the outside borders of both tables. In addition, the numeral "5" and "Figure 1" on the left-hand margin have been deleted and replaced in the center with the title --FIG. 1--. Two occurrences of each of the following have been inserted below the columns: --①--, --②--, --③--, --④--, and --⑤--. No new matter has been added.

<u>**REMARKS**</u>

The Office Action of December 1, 2011, has been received and reviewed. Claims 1 through 14 are currently pending in the application. Claims 1 through 14 stand rejected. Applicants have amended claims 1 through 14, added new claims 16 through 21. The amendments to the claims and the subject matter for the new claims is supported at least by ¶¶ [0025]-[0030] of the as-filed specification. No new matter has been added. Applicants respectfully request reconsideration of the application as amended herein.

**Provisional Double Patenting Rejection Based on U.S. Patent No. 12/012,230**

Claims 1 through 14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1 through 13 and 15 through 20 of U.S. Patent Application No. 12/012,230.

U.S. Patent Application No. 12/012,230 is a continuation-in-part application of the present application, and is still pending before the Office. Applicants acknowledge the obviousness-type double patenting rejection and respectfully request that the Examiner hold the requirement for a terminal disclaimer in abeyance because the scope of the pending claims in these applications is not finalized. Thus, a determination of obviousness-type double patenting would not be appropriate at this time. Applicants would prefer that the Examiner reconsider the obviousness-type double patenting rejection after examination on the merits of all claims in the present application.

In addition, Applicants note that the present application is the earlier filed application of the two applications. The MPEP states that:

> If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.
>
> …
>
> If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal

disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. MPEP, 804(I)(B)(1).

In both of the above situations, the earlier-filed application is permitted to issue without the need of a terminal disclaimer. Thus, a terminal disclaimer will not be filed at this time for the present application for this additional reason.

## 35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent Publication No. 2003/0236116 to Marks et al. in View of U.S. Patent Publication No. 2003/0064802 to Rodgers et al. and Further in View of U.S. Patent No. 6,155,925 to Giobbi et al.

Claims 1 through 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0236116 to Marks et al. (hereinafter "Marks") in view of U.S. Patent Publication No. 2003/0064802 to Rodgers et al. (hereinafter "Rodgers") and further in view of U.S. Patent No. 6,155,925 to Giobbi et al. (hereinafter "Giobbi"). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness, the prior art reference itself (or references when combined) or "the inferences and creative steps that a person of ordinary skill in the art would [have] employ[ed]" at the time of the invention must teach or suggest all of the claim elements. *K.S.R. Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q.2d 1385 (2007); *see also* M.P.E.P. § 2143.03. Additionally, the Examiner must determine whether there is "an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* Further, rejections on obviousness grounds "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006)). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have

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prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that hindsight cannot be used. *KSR*, 550 U.S. at 421; *DyStar*, 464 F.3d at 1367.

1. <u>Claims 1 through 6</u>

Marks, Rodgers, and Giobbi when combined, do not teach, suggest, or otherwise render obvious "playing the game so that simulated reels of the gaming machine assume a specific configuration showing symbols across the simulated reels used in the game, wherein one or more of the symbols is displayed as a variable state scatter symbol having either an active state or an inactive state when revealed on its position on the simulated reels, wherein variable state scatter symbols displayed as having an inactive state are not considered for jack-pot game play," and "determining if scatter symbols displayed as having an active state appear across the simulated reels used in the game in a predefined manner and, if so, then paying the jackpot," as recited in independent claim 1, as currently amended.

Marks teaches a slot machine that issues a percentage of one or more progressive awards based upon any wager level. *See* Marks, Abstract. The Examiner has conceded that Marks "does not explicitly disclose that the scatter symbols can be a *variable* state scatter symbol, the variable state being either an active state, whereby said variable state scatter symbol acts as a scatter symbol, or an inactive state, whereby said variable state scatter symbol is not considered to be a scatter symbol, and wherein the probability of a variable state scatter symbol having an active state is dependent upon the size of the player's wager." Office Action, page 6 (emphasis in original). The Applicants agree with the Examiner at least to the extent of this deficiency acknowledged by the Examiner. Thus, Marks will not need to be further discussed.

The Examiner, however, alleges that Rodgers:

teaches a game where after the symbols are displayed, the symbols may be transformed into special symbols based on a transformation probability determined by the processor (see fig. 3, par. [0041], [0042], once a symbol is transformed, a special symbol is then activated). This is substantially similar to activating symbols because a symbol that is not transformed does not provide the player with any special award akin to how an inactive

scatter symbol does not provide a special award or jackpot. In addition, activating a scatter symbol could be interpreted to be transforming an inactive scatter symbol to an active scatter symbol. Office Action, page 6.

The Examiner concludes that "it would have been obvious . . . to combine the gaming machine and scatter symbols of Marks et al. with the symbol transformation of Rodgers et al. in order to transform (or activate) symbols into functional or special symbols for the evaluation of an award (see Rodgers, par. [0010])." Office Action, page 7. The Applicants respectfully disagree with this characterization of the teachings of Rodgers in relation to the language of claim 1.

Applicants respectfully assert that the process of "transformation" is significantly different than determining between either an active symbol or an inactive symbol as claimed. For example, Rodgers teaches a "gaming device which includes symbols having a transformation probability . . . the transformation probability of each of the displayed symbols . . . randomly determines which, if any, symbols are to be transformed into wild symbols." Rodgers, Abstract. The transformation probability is predetermined and based solely on the individual symbol (e.g., bars, cherries, etc.). *See* Rodgers, ¶ [0042]. FIG. 5B shows an example of such a transformation, in that the symbol 75a in the upper right hand location of the display has been transformed into a wild symbol, and where the other symbols of the display are not transformed and remain the same.

Applicants understand that the Examiner is interpreting that the transformed symbols of Rodgers are being interpreted as "active" symbols, while non-transformed symbols are being interpreted as "inactive" symbols. In other words, it is understood that the "wild" symbol is being interpreted as an active symbol, while the other symbols (e.g., heart, bar, etc.) are being interpreted as inactive symbols (because they did not transform). As a result, after the determination of whether or not to transform symbols, under this interpretation, both active and inactive symbols may be displayed by the reels.

Applicants respectfully assert that even if one assumes, *arguendo*, this interpretation of active symbols and inactive symbols, Rodgers does not teach "determining if scatter symbols displayed as having an active state appear across the simulated reels used in the game in a predefined manner and, if so, then paying the jackpot." For example, while the Examiner has

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asserted that only active symbols are used in determining a "special award", that assertion is not supported by the teachings of Rodgers.

Rodgers teaches that a transformed symbol is shown as a wild symbol or a functional symbol. Prior to any symbols being transformed, Rodgers specifically teaches that the game begins and "a plurality of reels are *activated*," (block 102), a plurality of symbols are then "randomly generated and displayed" (block 104). Rodgers, ¶ [0041] (emphasis added). After generating the original set of active symbols displayed on the reels, "the processor determines conventional wins, if any." Rodgers, ¶ [0041]. Therefore, even Rodgers recognizes that there is a difference between an active symbol and a transformed symbol. The active symbol is a symbol having an active state, and is used to determine certain winning combinations. With that recognition, Rodgers begins with the assumption that the original set of symbols (prior to transformation) are all activated for determining winning combinations.

After the initial determination of any conventional wins, the processor then "determines whether to transform a first symbol based on the transformation probability associated with that symbol" (block 108). Rodgers, ¶ [0042]. According to a transformation probability, "the processor [may transform] the symbol into a wild symbol or other functional symbol." Rodgers, ¶ [0042]. Throughout the specification, Rodgers teaches that after regular symbols are transformed into wild symbols, the processor again evaluates whether the player has achieved any winning outcomes.

For example, Rodgers teaches two scenarios. The first scenario is that the transformation determination is made for all symbols that are displayed, after which "the processor determines whether the player has achieved any winning outcomes after transforming all appropriate symbols." Rodgers, ¶ [0007]. In the second scenario, the transformation determination is made for symbols successively. For example, "the processor transforms a first symbol into a wild symbol and determines if the player has achieved any winning outcomes. The first symbol reverts back to its original state and the processor transforms a second symbol into a wild symbol." Rodgers ¶ [0007]. Rodgers teaches that the "processor then determines if the player has achieved any winning outcomes based on the second transformation." Rodgers, ¶ [0007]. Other embodiments teach the same determination of winning outcomes after transforming symbols. *See also* Rodgers, ¶¶ [0042], [0043], [0050], [0053].

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Therefore, as is clear from the teachings of Rodgers, all displayed symbols are taught to be active and used in the determination of winning outcomes regardless of whether or not they were transformed. For example, it would not make sense that only the transformed symbol shown in FIG. 5B would be used to determine winning outcomes. In other words, if one were to adopt the Examiner's interpretation that transformed symbols are "active" and non-transformed symbols are "inactive" that would mean that only wild symbols are used to determine a jackpot while the other symbols of FIG. 5B (i.e., the bars, hearts, 7, and cherries) would not be used to determine a jackpot. Such an interpretation is clearly contrary to the teachings of Rodgers that winning outcomes are determined after each round of transformation where combinations of all displayed symbols are considered. Although a "wild" symbol is not specifically defined by Rodgers, a wild symbol is a common term used in the art of gambling to mean a symbol that could be any symbol among the possible symbols of the game. In other words, the wild symbol in FIG. 5B may be each of a bar, a cherry, a 7, and a heart for purposes of determining winning combinations with the other displayed symbols. The transformed wild symbol of Rodgers is taught to merely increase the probability of having a winning combination. Rodgers does not teach that only transformed wild symbol are used to make a determination for a jackpot, but rather that the wild symbols are considered along with the other displayed symbols (whether transformed or not) for all winning combinations offered by the gaming device of Rodgers. For example, the wild symbol in FIG. 5B would be combined with the other non-transformed symbols (e.g., bar, a cherry, a 7, and a heart) to determine if there are any winning combinations.

Therefore, as is clear from both the as-filed specification as well as the teachings of Rodgers, the displayed symbol and the state of that displayed symbol are different features. To clarify this distinction, and in an effort to advance prosecution, claim 1 has been amended to recite, in part, "wherein one or more of the symbols is displayed as a variable state scatter symbol having either an active state or an inactive state when revealed on its position on the simulated reels, wherein variable state scatter symbols displayed as having an inactive state are not considered for jack-pot game play," In contrast, Rodger's transformation only addresses which symbol is to be displayed, but does not teach any determination whether that symbol is to be displayed as having an active state or an inactive state.

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In other words, the symbol that is actually displayed on the reel is based on a determination that is different than the determination of whether or not the symbol is displayed as having either an active state or an inactive state. This is different than the symbols in Rodgers where a symbol (e.g., a cherry) is displayed as having an active state, and a transformed symbol (e.g., a wild) is displayed as also having an active state. As discussed above, Rodgers describes that winning events are determined before transformation, as well as after transformation, and such winning events include combinations of symbols that are both transformed as well as not transformed as displayed at the time of the determination.

Applicants note that this argument should not be interpreted to necessarily exclude a transformed symbol from having an active state or an inactive state that is probabilistically determined. In other words, this argument does not address whether or not a symbol that has both an active state or inactive state may be transformed into another symbol. This argument only discusses whether a non-transformed symbol is considered "inactive" even though such a non-transformed symbol is used to determine jackpot winning combinations according to the teachings of Rodgers. As discussed above, Rodgers even recognized that the displayed symbol itself and the state of that symbol are different features, and that prior to any transformation, all the reels are activated (block 102 of FIG. 3). Therefore, the transformation probability used in Rodgers determines transformation of an active symbol on an active reel to a different active symbol on the active reel. In all embodiments, all of the symbols are used to determine whether a winning combination exists, with the only difference being that the transformed symbols may be wild and increase the odds of having a winning combination.

It is further noted that another embodiment taught by Rodgers teaches transforming a symbol to a "functional" symbol, such as a credit value. *See* Rodgers, ¶ [0041]. Again, this "functional" symbol is transformed from an active symbol, and merely determines whether the player gets a "credit." Such a credit may be merely an indication of winning an additional game or as a trigger to enter into a bonus game. *See* Rodgers, ¶ [0048]. Therefore, even in the additional embodiments taught by Rodgers, the transformation probability does not determine whether or not a symbol is displayed as having an active state or an inactive state where only symbols being displayed as having an active state are considered in the determination of jackpot winning events. The transformation probability of Rodgers merely determines whether one type

of symbol at an active location on the reel is replaced by another type of symbol on the same active location of the reel.

In addition, Giobbi does not cure these deficiencies of Marks and Rodgers. The Examiner has alleged that "Giobbi teaches a game where symbols can be activated for a game depending on the wager accepted by the gaming machine relative to a maximum allowable wager allowed by the gaming machine (see fig. 6a-6e, and col. 6, lines 45-61, larger wagers activate symbols for large fish, very large fish, etc.)" Office Action, page 7.

Giobbi, however, does not teach "wherein one or more of the symbols is displayed as a variable state scatter symbol having either an active state or an inactive state when revealed on its position on the simulated reels, wherein variable state scatter symbols displayed as having an inactive state are not considered for jack-pot game play." For example, the fish symbols of Giobbi relied upon by the Examiner are part of a bonus game that simulates a fishing game "wherein the player selects a lucky boat 64 by touching the touch screen video display 20." Giobbi, col. 5, line 67 – col. 6, line 2. The large fish, very large fish, etc. symbols are not variable state symbols that are part of the reels of the slot machine game play. Rather, the various fish symbols are described as being part of a separate bonus game. In addition, as shown in FIGS. 6a-6e of Giobbi, the various fish symbols are simply introduced into the bonus game based on the size of the wager. In other words, if a certain wager is provided, an additional symbol is introduced among the possible outcomes. Once introduced into the bonus game, the new symbols are randomly chosen; however, if chosen, the symbols are only displayed as having an active state. Therefore, there is no "inactive" state for symbols that are introduced into the game. Therefore, the fish symbols are not displayed as having an active state or an inactive state.

In addition, even if one assumes, *arguendo*, that being introduced into the game is an "active state," and not being introduced into the game is an "inactive state," Giobbi does not teach any probability that the new symbol could be displayed as being inactive. In other words, according to FIG. 6a, if 1-5 credits are wagered, only a small fish and a medium fish are introduced among the possible outcomes. According to FIG. 6b, if 6-10 credits are wagered, a large fish is introduced among the possible outcomes of the bonus game, and so on. Thus, the wager determines whether or not the type of fish is merely introduced into the game. The actual decision on whether to introduce the type of fish into the game is not itself probabilistically

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determined in any way. If the large fish, very large fish, etc. symbols are not introduced (because of a low wager), the symbols will not be displayed at all as the symbol will not be part of the game.

Therefore, Marks, Rodgers, and Giobbi, when combined, do not teach, suggest, or otherwise render obvious all the limitations recited in independent claim 1. As a result, independent claim 1 would not have been obvious to a person of ordinary skill in the art at the time the invention was made considering Marks, Rodgers, and Giobbi. The Applicants respectfully request that the Examiner withdraw the rejection of independent claim 15 under 35 U.S.C. § 103(a).

Claims 2 through 6 depend from independent claim 1, which is allowable. Therefore, at least by virtue of their dependence from an allowable claim, claims 2 through 6 are also allowable. The Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 2 through 6.

2.     Claim 7

Independent claim 7 includes subject matter similar to that of claim 1. In particular, claim 7 recites, "the displayed scatter symbols being randomly selected from a set of symbols that are to be displayed at active positions and inactive positions of the one or more reels," and "determining the jackpot being won by comparing scatter symbols at only active positions of the one or more reels in the game outcome display with a predetermined combination, wherein the probability that a position of the one or more reels is selected as an active position on the one or more reels in the game outcome display is dependent upon a size of the player's wager relative to a maximum possible wager for the simulated reels gaming machine."

As a result, the analysis presented above with respect to claim 1 is also applicable to claim 7. For those reasons, a rejection of claim 7 based on Marks, Rodgers, and Giobbi is improper, and the Applicants respectfully request that the rejection of claim 7 under 35 U.S.C. § 103(a) be withdrawn.

3.    Claim 8

Claim 8 recites a "system for operating a linked jackpot, comprising at least a plurality of gaming machines linked to a central jackpot controller, the central jackpot controller and the at least a plurality of gaming machines cooperating to implement the method of claim 1."

Therefore, for the reasons described above with respect to claim 1, claim 8 is also allowable over Marks, Rodgers, and Giobbi. The Applicants respectfully request that the rejection of claim 8 under 35 U.S.C. § 103(a) be withdrawn.

4.    Claims 9 through 13

Independent claim 9 includes subject matter similar to that of claim 1. In particular, claim 9 recites, "wherein one or more of the symbols is a variable state scatter symbol being displayed as having either an active state or an inactive state when revealed at its corresponding location on the multiple simulated reels, wherein the variable state scatter symbol in its active state is considered to be a scatter symbol for jackpot determining purposes, and wherein the variable state scatter symbol in its inactive state is not considered to be a scatter symbol for jackpot determining purposes, wherein a probability of a variable state scatter symbol having an active state is dependent upon a size of the player's wager."

As a result, the analysis presented above with respect to claim 1 is also applicable to claim 9. For those reasons, a rejection of claim 9 based on Marks, Rodgers, and Giobbi is improper, and the Applicants respectfully request that the rejection of claim 9 under 35 U.S.C. § 103(a) be withdrawn.

Claims 10 through 13 depend from independent claim 9, which is allowable. Therefore, at least by virtue of their dependence from an allowable claim, claims 10 through 13 are also allowable. The Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 10 through 13.

5.    Claim 14

Independent claim 14 includes subject matter similar to that of claim 1. In particular, claim 14 recites, "wherein the processor is programmed to indicate one or more reels used in the game to randomly display symbols having a fixed active state, and at least one reel to randomly

display symbols having either an active state or inactive state according to a variable state probability, wherein a jackpot for the game is won by a predetermined combination of symbols from all reels that are displayed in a game outcome display to have an active state, wherein the variable state probability for having an active state on the game outcome display is dependent upon a size of the player's wager relative to a maximum possible wager for the gaming machine."

As a result, the analysis presented above with respect to claim 1 is also applicable to claim 14. For those reasons, a rejection of claim 14 based on Marks, Rodgers, and Giobbi is improper, and the Applicants respectfully request that the rejection of claim 14 under 35 U.S.C. § 103(a) be withdrawn.


**New Claims 16 through 21**

New claims 16 through 21 are added. Claims 16 through 18 depend from claim 1, claims 19 and 20 depend from claim 9, claim 21 depends from claim 14. As discussed above, Applicants assert that claims 1, 9, and 14 are allowable. Therefore, claims 16 through 21 are allowable at least by virtue of their dependence from an allowable claim. In addition, Applicants respectfully assert that Marks, Rodgers, and Giobbi do not teach, suggest, or otherwise render obvious the additional limitations recited by claims 16 through 21, which are allowable for this additional reason.

## CONCLUSION

Claims 1 through 14 and 16 through 21 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

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Date: February 27, 2012
SWG/vmm:cs

Attachments: Appendices A and B
Replacement drawing
Annotated sheet showing changes made